

## Applicant Details

First Name **Ebehireme**  
 Last Name **Inegbenebor**  
 Citizenship Status **U. S. Citizen**  
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Address

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<b>Street</b> <b>8250 Georgia Avenue, Apt 1103</b> <b>City</b> <b>Silver Spring</b> <b>State/Territory</b> <b>Maryland</b> <b>Zip</b> <b>20910</b> <b>Country</b> <b>United States</b>

Contact Phone Number **4102415644**

## Applicant Education

BA/BS From **University of Pennsylvania**  
 Date of BA/BS **December 2018**  
 JD/LLB From **Howard University School of Law**  
[http://www.nalplawsonline.org/ndlsdir\\_search\\_results.asp?lscd=50906&yr=2011](http://www.nalplawsonline.org/ndlsdir_search_results.asp?lscd=50906&yr=2011)  
 Date of JD/LLB **May 11, 2024**  
 Class Rank **10%**  
 Law Review/Journal **Yes**  
 Journal(s) **Howard Law Journal**  
 Moot Court Experience **No**

## Bar Admission

## Prior Judicial Experience

Judicial  
Internships/        **No**  
Externships  
Post-graduate  
Judicial Law       **No**  
Clerk

### **Specialized Work Experience**

Specialized Work    **Appellate**  
Experience

### **Recommenders**

Schneider, Valerie  
vschneider@law.howard.edu  
202-806-8119

Gavil, Andrew  
agavil@law.howard.edu  
202-806-8018

Ginzburg, Maria  
mginzburg@selendygay.com  
2123909006

**This applicant has certified that all data entered in this profile and  
any application documents are true and correct.**

**Ebehireme “Ebe” Inegbenebor**

Ebehireme.Inegbeneb@law.bison.howard.edu | (410) 241-5644  
8250 Georgia Avenue, Apt. 1103, Silver Spring, MD 20910

June 8, 2023

The Honorable Alfred H. Bennett  
U.S. District Court for the Southern District of Texas  
United States Courthouse  
515 Rusk Street  
Houston, TX 77002

Dear Judge Bennett:

I am a rising third-year law student at Howard University School of Law, and I am applying for a two-year clerkship position in your chambers to begin in 2024. I am eager for the opportunity to strengthen my analytical and writing skills while gaining exposure to the wide variety of legal issues before the U.S. District Court for the Southern District of Texas. I have a demonstrated interest in a career as a litigator, and my experiences to date have prepared me to undertake the responsibilities of a clerkship in your chambers.

I have developed strong analytical, research, and writing skills through my academic and professional experiences. In my current 2L summer, I am working with Kannon Shanmugam in the appellate group of Paul, Weiss, Wharton, Rifkind & Garrison’s Washington D.C. office, where I have been staffed on matters ranging from antitrust to immigration. I have also committed to an externship at the U.S. Department of Justice Civil Division’s Appellate Staff for fall of 2023. My motivation to pursue these opportunities arose from prior legal experience that reinforced my commitment to a litigation career. For instance, during my first law school summer at Selendy Gay Elsberg in New York, I received excellent feedback on appellate briefs and research assignments that I drafted. Additionally, as a student-attorney in Howard Law’s Civil Rights Appellate Clinic, I wrote an appellate brief that I argued in moot court and co-drafted a petition for certiorari filed at the U.S. Supreme Court. All these experiences and more will have fine-tuned my research and writing skills before working in your chambers.

I believe other aspects of my background will likewise serve me well as a law clerk working on complex issues of federal law. Before law school, I gained significant experience working with securities, banking, and federal administrative agencies, including the U.S. Department of the Treasury, while working at Goldman Sachs, Bank of America Private Bank, and Accenture Consulting. These roles exposed me to varying application of federal law while developing my attention to detail and an ability to work in fast-paced, demanding environments. Additionally, as a teaching assistant for Legislation & Regulation, I practiced distilling complex information to assist first-year law students in learning topics in statutory interpretation and administrative law.

In sum, clerking in your chambers would be a great opportunity, and I am confident I will make valuable contributions to your work. Enclosed are my resumé, transcripts, and writing sample. Letters of recommendation from Maria Ginzburg, a partner at Selendy Gay Elsberg, and Howard Law Professors Andrew Gavil and Valerie Schneider will arrive under separate cover. If you would like to speak to Kannon Shanmugam or Raymond Tolentino, they welcome your call (contact information attached). Should you require additional information, please do not hesitate to let me know. Thank you for your consideration.

Warmly,



Ebe Inegbenebor  
Enclosures

**Ebehireme “Ebe” Inegbenebor**

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8250 Georgia Avenue, Apt. 1103, Silver Spring, MD 20910

**REFERENCES**

**Kannon Shanmugam**

Managing Partner at Paul, Weiss, Wharton, Rifkind & Garrison’s Washington D.C. Office  
2001 K Street N.W.  
Washington D.C. 20006  
(202) 223-7325  
kshanmugam@paulweiss.com  
*Supervising Partner for Appellate Matters*

**Raymond Tolentino**

Partner at Kaplan, Hecker & Fink LLP  
Visiting Professor at Howard University School of Law’s Civil Rights Appellate Clinic  
1050 K Street N.W.  
Washington D.C. 20001  
(202) 742-2661  
rtolentino@kaplanhecker.com  
*Clinical Law Professor in fall of 2022*

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8250 Georgia Avenue, Apt. 1103, Silver Spring, MD 20910

### EDUCATION

**Howard University School of Law**, Washington, D.C.

Expected May 2024

Juris Doctor Candidate

**GPA:** 89.49/100 (top 10%)

**Honors:** Merit Scholar

**Activities:** Senior Staff Editor on the *Howard Law Journal*, Civil Rights Appellate Clinic, Teaching Assistant for Legislation & Regulation, Incoming Teaching Assistant for Property Law, The Appellate Project (TAP) Mentee

**Note (working product):** *Power at What Cost: A Discussion of Moore v. Harper as an Example of the Supreme Court’s Continued Trend Towards Immense Power*

**University of Pennsylvania**, Philadelphia, PA

December 2018

B.A. in Political Economics, Minors in Development and Africana Studies

**Honors:** 2017–2018 Dean’s List (3.7+ GPA), Onyx Senior Honor Society Founder’s Award, Ron Brown CAPtain Scholar

**Activities:** Penn Undergraduate Urban Research Colloquium, Lauder Institute’s Think Tanks and Civil Societies Program, Wharton African Business Forum, Founder of West African Vibe Dance Group

**University of Pennsylvania Carey Law School’s Global Institute for Human Rights**

May 2018

Certificate in Global Human Rights Law, Concentrations in Business & Human Rights and Gender & Human Rights

### EXPERIENCE

**U.S. Department of Justice, Civil Division, Appellate Section**, Washington, D.C.

*Incoming Fall Extern*

August 2023 – December 2023

**Paul, Weiss, Rifkind, Wharton & Garrison LLP**, Washington, D.C.

*Summer Litigation Associate and Pauli Murray Fellow*

May 2023 – July 2023

**Howard University School of Law Civil Rights Appellate Clinic**, Washington, D.C.

*Student Attorney*

August 2022 – December 2022

- Co-wrote a petition for certiorari with two other student-attorneys filed at the U.S. Supreme Court for *N.S. v. Kansas City Board of Police Commissioners*, No. 22-556, challenging the qualified immunity doctrine
- Drafted mock appellate briefs and participated in a mock oral argument on a *Batson* challenge issue

**Selendy Gay Elsberg, PLLC**, New York, N.Y.

*Summer Litigation Associate*

May 2022 – July 2022

- Co-drafted two amicus briefs filed at the N.Y. Court of Appeals and the U.S. Court of Appeals for the Second Circuit
- Drafted extensive legal memoranda for employment discrimination claims and a FINRA securities arbitration
- Attended federal trial court hearings and oral arguments on appeal; participated in a mock trial training

**Accenture Federal Services**, Washington, D.C.

*Management Consulting Senior Analyst*

June 2020 – August 2021

- Collaborated with leadership at the U.S. Department of Treasury to develop a long-term strategy for overhauling the IRS’s organizational structure and IT architecture to align with the 2019 Taxpayer First Act

**Bank of America Private Bank**, Washington, D.C.

*Investment Management & Wealth Development Analyst (management pipeline program)*

February 2019 – May 2020

- Proposed strategic plans to bring in new business, track incoming revenue, and coordinate prospecting event planning
- Produced a program that analyzed market returns for a large client’s portfolio, which helped raise \$3.5M for the Bank

**Goldman Sachs**, New York, N.Y.

*Summer Analyst, Regulatory Monitoring & Operations*

June 2017 – August 2017

- Coded semi-automatic FINRA reporting procedures that improved the organization’s reporting timeliness

### PUBLICATION

- James G. McGann, et al., *Fit for the Future: Enhancing the Capacity, Quality, and Sustainability of Africa’s Think Tanks*, TTCSP GLOB. & REG’L THINK TANK SUMMIT REPS (2017).

### INTERESTS

Civil rights, Chimamanda Adichie’s novels, Afrobeat dance and music, Bikram yoga



# GRADING POLICY/GRADE CUT-OFFS

THE CURRENT GRADING POLICY AND GRADE CUT-OFFS FOR THE CLASSES OF 2022 AND 2023 ARE AS FOLLOWS:

OUT OF A SCALE OF 100

## CLASS OF 2023

Class Rank	Cum GPA
Top 10%	89.97-above
Top 15%	88.77-above
Top 25%	86.90-above
Top 33%	85.13-above

## CLASS OF 2024

Class Rank	Cum GPA
Top 10%	88.7-above
Top 15%	87.6-above
Top 25%	86.17-above
Top 33%	84.67-above

## FINAL GRADES SYSTEM

A	90-100
B	80-89
C	70-79
D	60-69
F	50-59

## 4-POINT SCALE CONVERSION

Cum GPA	Standard GPA
90-100	4.0
89-85	3.99 - 3.50
84-80	3.40 - 3.00
79-75	2.99 - 2.50
74-70	2.49 - 2.00
69-65	1.99 - 1.50
64-60	1.49 - 1.00
59-less	.99 - less

A J.D. student will be placed on academic probation if the student has a cumulative weighted grade point average between 72.00 and 74.99 after the end of the first year. A student who is on academic probation after the end of the first year must also participate in the upper-class Academic Support Program. Failure to participate in the Academic Support Program is grounds for dismissal. With the exception of the summer semester, probation shall terminate during the semester in which the student obtains a cumulative GPA of 75.

# Display Transcript

@02748566 Ebehireme E. Inegbenebor  
May 15, 2023 12:56 am



This is NOT an official transcript. Courses which are in progress may also be included on this transcript.

[Institution Credit](#) [Transcript Totals](#) [Courses in Progress](#)

## Transcript Data

### STUDENT INFORMATION

#### Curriculum Information

##### Current Program

Juris Doctor

**Program:** Juris Doctor

**College:** School of Law

**Major and Department:** Law, Law

\*\*\*Transcript type:WEB is NOT Official \*\*\*

### INSTITUTION CREDIT [-Top-](#)

#### Term: Fall 2021

**College:** School of Law

**Major:** Law

**Student Type:** First-Time Professional

##### Academic Standing:

Subject	Course	Campus	Level	Title	Grade	Credit Hours	Quality Points	Start and End Dates	R	CEU Contact Hours
LAW	507	Main	LW	Leg. Reg.	97	3.000	291.00			
LAW	617	Main	LW	Torts	85	4.000	340.00			
LAW	619	Main	LW	Civil Procedure I	85	4.000	340.00			

#### Term Totals (Law)

	Attempt Hours	Passed Hours	Earned Hours	GPA Hours	Quality Points	GPA
<b>Current Term:</b>	11.000	11.000	11.000	11.000	971.00	88.27
<b>Cumulative:</b>	11.000	11.000	11.000	11.000	971.00	88.27

Unofficial Transcript

#### Term: Spring 2022

**College:** School of Law

**Major:** Law

**Student Type:** Continuing

**Academic Standing:** Good Standing

Subject	Course	Campus	Level	Title	Grade	Credit Hours	Quality Points	Start and	R	CEU Contact Hours
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5/15/23, 12:58 AM

Academic Transcript

							End Dates
LAW	612	West/Law	LW	Constitutional Law I	88	3.000	264.00
LAW	613	West/Law	LW	Legal Reasoning Research Writ	88	4.000	352.00
LAW	614	West/Law	LW	Property	96	4.000	384.00
LAW	615	Main	LW	Contracts	84	5.000	420.00
LAW	616	West/Law	LW	Criminal Law	80	3.000	240.00

**Term Totals (Law)**

	Attempt Hours	Passed Hours	Earned Hours	GPA Hours	Quality Points	GPA
<b>Current Term:</b>	19.000	19.000	19.000	19.000	1660.00	87.37
<b>Cumulative:</b>	30.000	30.000	30.000	30.000	2631.00	87.70

Unofficial Transcript

**Term: Fall 2022**

**College:** School of Law  
**Major:** Law  
**Student Type:** Continuing

**Academic Standing:**

Subject	Course	Campus	Level	Title	Grade	Credit Hours	Quality Points	Start and End Dates	R	CEU Contact Hours
LAW	621	Main	LW	Constitutional Law II	86	3.000	258.00			
LAW	654	Main	LW	Legal Writing II	90	2.000	180.00			
LAW	680	Main	LW	Federal Courts	92	3.000	276.00			
LAW	721	Main	LW	Civil Rights Clinic I	92	6.000	552.00			

**Term Totals (Law)**

	Attempt Hours	Passed Hours	Earned Hours	GPA Hours	Quality Points	GPA
<b>Current Term:</b>	14.000	14.000	14.000	14.000	1266.00	90.43
<b>Cumulative:</b>	44.000	44.000	44.000	44.000	3897.00	88.57

Unofficial Transcript

**Term: Spring 2023**

**College:** School of Law  
**Major:** Law  
**Student Type:** Continuing

**Academic Standing:**

Subject	Course	Campus	Level	Title	Grade	Credit Hours	Quality Points	Start and End Dates	R	CEU Contact Hours
LAW	414	Main	LW	Envir. & Energy Adm. & Reg Law	90	2.000	180.00			
LAW	629	West/Law	LW	Evidence	96	4.000	384.00			
LAW	698	West/Law	LW	CD: Supreme Ct Jurisprudence	94	3.000	282.00			
LAW	760	West/Law	LW	Trial Advocacy/Civil Exp	P	2.000	0.00			



5/15/23, 12:58 AM

Academic Transcript

**Term Totals (Law)**

	<b>Attempt Hours</b>	<b>Passed Hours</b>	<b>Earned Hours</b>	<b>GPA Hours</b>	<b>Quality Points</b>	<b>GPA</b>
<b>Current Term:</b>	11.000	11.000	11.000	9.000	846.00	94.00
<b>Cumulative:</b>	55.000	55.000	55.000	53.000	4743.00	89.49

Unofficial Transcript

**TRANSCRIPT TOTALS (LAW)** [-Top-](#)

	<b>Attempt Hours</b>	<b>Passed Hours</b>	<b>Earned Hours</b>	<b>GPA Hours</b>	<b>Quality Points</b>	<b>GPA</b>
<b>Total Institution:</b>	55.000	55.000	55.000	53.000	4743.00	89.49
<b>Total Transfer:</b>	0.000	0.000	0.000	0.000	0.00	0.00
<b>Overall:</b>	55.000	55.000	55.000	53.000	4743.00	89.49

Unofficial Transcript

**COURSES IN PROGRESS** [-Top-](#)

**Term: Fall 2021**

**College:** School of Law  
**Major:** Law  
**Student Type:** First-Time Professional

<b>Subject</b>	<b>Course</b>	<b>Campus</b>	<b>Level</b>	<b>Title</b>	<b>Credit Hours</b>	<b>Start and End Dates</b>
LAW	613	Main	LW	Legal Reasoning Research Writ	0.000	
LAW	615	Main	LW	Contracts	0.000	

Unofficial Transcript

**Term: Fall 2022**

**College:** School of Law  
**Major:** Law  
**Student Type:** Continuing

<b>Subject</b>	<b>Course</b>	<b>Campus</b>	<b>Level</b>	<b>Title</b>	<b>Credit Hours</b>	<b>Start and End Dates</b>
LAW	805	Main	LW	Law Journal-2L	1.000	

Unofficial Transcript

**Term: Spring 2023**

**College:** School of Law  
**Major:** Law  
**Student Type:** Continuing

<b>Subject</b>	<b>Course</b>	<b>Campus</b>	<b>Level</b>	<b>Title</b>	<b>Credit Hours</b>	<b>Start and End Dates</b>
LAW	687	West/Law	LW	Professional Responsibility	3.000	
LAW	805	West/Law	LW	Law Journal-2L	0.000	

Unofficial Transcript

**Term: Fall 2023**

5/15/23, 12:58 AM

Academic Transcript

**College:** School of Law  
**Major:** Law  
**Student Type:** Continuing

Subject	Course	Campus	Level	Title	Credit Hours	Start and End Dates
LAW	509	Main	LW	CD: Civil Lit. Practice	1.000	
LAW	525	Main	LW	Advanced Civil Procedure	3.000	
LAW	642	Main	LW	Criminal Procedure I	3.000	
LAW	647	Main	LW	Family Law	3.000	
LAW	769	Main	LW	CD: Business Organizations	3.000	
LAW	805	Main	LW	Law Journal-3L	1.000	

Unofficial Transcript

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RELEASE: 8.7.1

SITE MAP

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**WRITING SAMPLE**

My writing sample is an assignment that I submitted as a student in the Supreme Court Jurisprudence seminar at Howard University School of Law. In this seminar, students were tasked with reading briefs and pertinent case law to decide three cases pending before the U.S. Supreme Court this past term chosen by our professors. While acting as “Supreme Court justices,” we discussed the briefs and legal arguments before voting on the questions presented. We then individually wrote “Supreme Court opinions” based on our analysis and perspectives on the law.

This “opinion” is for *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 598 U.S. \_\_\_\_ (2023) (No. 22–148), in which the Supreme Court will decide whether the First Amendment shields respondent VIP’s humorous use of petitioner Jack Daniel’s trade dress to make dog toys from trademark infringement liability under the Lanham Act.<sup>1</sup> The questions presented are:

1. Whether humorous use of another’s trademark as one’s own on a commercial product is subject to the Lanham Act’s traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark infringement claims; and
2. Whether humorous use of another’s mark as one’s own on a commercial product is “noncommercial” under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act.

On the first question, my opinion argues that VIP’s humorous use of Jack Daniel’s trade dress may fall outside the scope of First Amendment protection, and thus become subject to the Lanham Act, because VIP’s use of the trademark could be considered deceptive or tarnishing to Jack Daniel’s brand. On the second question, my opinion argues that because VIP sold the dog toys in commerce and the use of Jack Daniel’s mark was VIP’s selling point for the dog toys, this constituted commercial use. My opinion vacates the judgment below and remands the case to the district court for further inquiry into whether VIP’s use of Jack Daniel’s mark was deceptive or tarnishing.

Per the assignment’s requirements, the background section is shorter than it would be in an actual Supreme Court opinion. Aside from my final grade on the assignment, this opinion is entirely my own work. I have not received any feedback, nor has it been edited by others.

<sup>1</sup> As of the date that this clerkship application is submitted, the Supreme Court has not yet decided the case.

Cite as: 598 U.S. \_\_\_\_ (2023)

1

Opinion of the Court

**SUPREME COURT OF THE UNITED STATES**

\_\_\_\_\_  
No. 22–148

JACK DANIELS PROPERTIES, INC., PETITIONER

v.

VIP PRODUCTS LLC

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF  
APPEALS FOR THE NINTH CIRCUIT

[March 21, 2023]

JUSTICE INEGBENEBOB delivered the opinion of the Court.

The provisions of the Lanham Act allow a plaintiff to bring a cause of action for trademark dilution or infringement. 15 U.S.C. §§ 1114–18, 1125, 1127. The Trademark Dilution Revision Act of 2006, *id.* at § 1125(c)(3)(C), states that “any noncommercial use of a mark \* \* \* shall not be actionable as \* \* \* dilution by tarnishment \* \* \* .”

The questions presented here are coupled. *First*, we discuss whether humorous use of another’s trademark as one’s own on a commercial product is subject to the Lanham Act’s traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark infringement liability. *Second*, we discuss whether humorous use of another’s mark as one’s own on a commercial product is “noncommercial” under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act. We hold that humorous use of another’s mark falls

## 2 JACK DANIEL'S PROPERTIES, INC. V. VIP PRODUCTS LLC

## Opinion of the Court

outside the scope of First Amendment protection, and thus becomes subject to the Lanham Act, when the use of the mark becomes deceptive or tarnishing to a brand. Accordingly, humorous use of another's mark to place a product in the stream of commerce is commercial by definition.

## I

Jack Daniel's Properties, Inc. ("JDP") is a 148-year-old U.S.-based company known for its manufacturing and distillation of liquors, primarily whiskey products. Valued at \$6.5 million, its large brand is well-known for its trade dress: a distinctive square prismatic bottle shape with "Jack Daniel's Tennessee WHISKEY, old No. 7" as an arched logo written in white Jasper font and twirling white lines against a black label. The brand has become an "icon" of sorts.<sup>1</sup> It has remained consistent for much of the company's existence and has a significant effect on JDP's profits.

VIP Products LLC ("VIP") is the United States' second largest manufacturer of dog toys and sells its products both domestically and internationally at pet suppliers and common retailers, such as Amazon, Inc. and Walmart, Inc. Its brand is rooted in parody—the company is known to create humorous near-replicas of iconic brands in the form of dog toys to sell to consumers without first obtaining licenses. One such product is its "Bad Spaniels" toy. Similar to the traditional Jack Daniel's trade dress, the Bad Spaniels toy mimics the square prismatic bottle shape of the Tennessee Whiskey bottle with writing in a similar font against the same black label and "Bad Spaniels" appearing in arched

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<sup>1</sup> Br. for Resp't at 3.

## 3 JACK DANIEL'S PROPERTIES, INC. V. VIP PRODUCTS LLC

## Opinion of the Court

form. The principal difference is that the writing's substance references canine feces and features an image of a Spaniel breed dog. The back of the product's hang tag states in small-scale script, "This product is not affiliated with Jack Daniel Distillery."<sup>2</sup>

JDP sought to enjoin VIP's sale of Bad Spaniels under the Lanham Act, claiming that the toy likely confused consumers and thus infringed on Jack Daniel's marks and trade dress, 15 U.S.C. §§ 1114(1), 1125(a), and diluted Jack Daniel's famous marks by tarnishment by associating them with canine feces and with products that appeal to children, *id.* at § 1125(c)(1). The District Court agreed. *VIP Prod., LLC v. Jack Daniel's Properties, Inc.*, No. CV-14-2057-PHX-SMM, 2016 WL 5408313 (D. Ariz. Sept. 27, 2016), *rev'd*, 953 F.3d 1170 (9th Cir. 2020).

The Court of Appeals reversed. *Id.* Despite agreeing that VIP's product was likely to confuse consumers, the Ninth Circuit relied on *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), to hold that VIP's "humorous" dog toy was an "expressive work" warranting heightened First Amendment protection from infringement liability.<sup>3</sup> The court further held that VIP's use of Jack Daniel's marks to sell its dog toy was "noncommercial" and thus immune from dilution liability because the toy was "humorous."

We granted JDP's petition for certiorari. JDP argues that the Court of Appeals' ruling erroneously abrogates trademark protections afforded by the Lanham Act by imposing heightened requirements on trademark owners to prove infringement in cases involving humor. JDP also argues that the meaning of "noncommercial use" as it is used in the Trademark Dilution

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<sup>2</sup> Pet. App. 6a.

<sup>3</sup> Pet. App. 31a.

## 4 JACK DANIEL'S PROPERTIES, INC. V. VIP PRODUCTS LLC

## Opinion of the Court

Revision Act should not include the use of a mark to sell a product. We agree with JDP in certain respects.

## II

We disagree with the standard that the Court of Appeals applied in determining that VIP's product was not subject to Lanham Act infringement liability. Although parody warrants some First Amendment protection, this protection is limited when use of a mark becomes deceptive or tarnishing to a brand.

The Lanham Act prohibits the use of words or symbols likely to mislead consumers about a product's source. 15 U.S.C. §§ 1114(1)(a), 1125(a). The statute requires that the defendant's use be "likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1114(1)(a); *see also id.* at § 1125(a) ("likely to cause confusion, or to cause mistake, or to deceive \* \* \* as to the origin, sponsorship, or approval"). This "likely to cause confusion \* \* \*" element should not be restricted to a consumer's potential confusion between products on a store's shelf; consumers make mental associations with brands, and another product that is too similar to a trademark can alter those mental associations.

In 2006, Congress passed the Trademark Dilution Revision Act ("TDRA"), 15 U.S.C. § 1125(c), which amended the preceding Federal Trademark Dilution Act of 1995 ("FTDA") in several ways to agree with our decision in *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

The two statutes in tandem provide trademark owners with a cause of action for dilution. The TDRA made various revisions to the FTDA, four of which are relevant here. First, the TDRA extended the FTDA to trademark uses that are even "*likely* to

## 5 JACK DANIEL'S PROPERTIES, INC. V. VIP PRODUCTS LLC

## Opinion of the Court

cause dilution.” 15 U.S.C. § 1125(c)(1) (emphasis added). Second, the TDRA clarified that dilution encompasses both dilution by “blurring” and dilution by “tarnishment.” *Id.* Dilution by blurring is any association that “impairs the distinctiveness of the famous mark,” while dilution by tarnishment is any association “that harms the reputation of the famous mark.” *Id.* at § 1125(c)(2)(B), (C); *see also Moseley*, 537 U.S. at 430, 432.

Third, Congress expanded the fair-use exclusion to cover other uses, like parody, as long as the defendant does not use the famous mark to designate the source of its own product. *Id.* at § 1125(c)(3)(A)(ii) (Fair use exclusion includes “use in connection with \* \* \* identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.”). Fourth, Congress defined a “famous” mark as one “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner,” and instructed courts to consider “all relevant factors” in making that determination. *Id.* at § 1125(c)(2)(A).

This Court has not addressed issues like those presented in this case, so the Ninth Circuit relied on *Rogers v. Grimaldi*, a decision out of the Second Circuit, to hold that VIP’s “humorous” dog toy was an “expressive work” warranting heightened First Amendment protection from infringement liability. 875 F.2d 994 (2d Cir. 1989).

In *Rogers*, musical star Ginger Rogers sued a movie producer over a film called “Ginger and Fred,” claiming that the title misled consumers into thinking she endorsed the film. The Second Circuit rightly expressed concern that “overextension of Lanham Act restrictions in the area of titles might intrude on First



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Amendment values.” *Id.* at 998. Based on this concern, it held that the Lanham Act “should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. In the context of “allegedly misleading titles,” the court held that the Act would not apply unless the title “ha[d] no artistic relevance to the underlying work whatsoever,” or “explicitly misle[d] as to the source or the content of the work.” *Id.*

The test arising from *Rogers* can be summarized as such: a challenged expression is protected from the Lanham Act under the First Amendment when a) the challenged expression has some artistic relevance to the underlying trademarked product and b) the challenged expression is not explicitly misleading as to the source of the content of the expression. The test attempts to strike a balance between protections we have constitutionalized under the First Amendment and the rights of business owners to own their product in a fair market. In practice, however, *Rogers* has overburdened the rights of business owners and overprotected the use of marks that constitute some sort of speech. The fact that nearly all uses of another’s trademark is speech *per se* significantly skews the balance in favor of defendants in trademark infringement and dilution claims.

We have repeatedly said that “not all speech is of equal First Amendment importance.” *Hustler Mag., Inc. v. Falwell*, 485 U.S. 46, 56 (1988) (quoting *Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749, 758 (1985)). The First Amendment protects speech that promotes our philosophical justifications for the dissemination of ideas, and speech that does not accomplish this goal requires further analysis to determine its First Amendment value. It is true that parody is generally protected

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because of its contribution to the marketplace of ideas and its promotion of self-governance and self-fulfillment. *See Hustlers*, 485 U.S. at 57. However, intentionally misleading speech has never been protected. *Id.* at 53 (“It is the intent to cause injury that is the gravamen of the tort \* \* \* ”); *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 (1976) (“Untruthful speech, commercial or otherwise, has never been protected for its own sake.”). Because of this consideration, the Second Circuit has even retreated from its original Rogers analysis. *Twin Peaks Prods., Inc. v. Publications Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993). In the context of commercial marketplaces, speech that crosses the line to become misleading to consumers is subject to narrowly tailored government restriction in order to promote fair market practices and encourage more knowledgeable consumers. The essence of a dilution claim is to preserve the value or “selling power” of famous marks, and this selling power also warrants protection. *See San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 541 (1987) (“The mere fact that [a defendant] claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to appropriate to itself the harvest of those who have sown.”).

Bearing this in mind, we are of the opinion that the test requires a larger burden shift to the defendant in a trademark dilution or infringement claim than already exists. As the Lanham Act currently requires, the party alleging dilution or infringement must prove actual dilution. Our precedent affirms this burden to establish a *prima facie* cause of action, and we maintain this precedent today. *Moseley*, 537 U.S. at 432–34.

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However, a challenged expression that has some artistic relevance to an underlying trademarked product need only have a *sufficiently compelling* likelihood of confusion with the trademarked product to fall within the scope of the Lanham Act. We believe that this modified standard will rightly place more requirements on the defendant to disprove likelihood of confusion beyond a label on the back of a product with miniscule text or a hidden disclaimer in the credits of a film production. At the same time, the artistic, expressive, or humorous nature of a defendant's use of a trademark is relevant in an analysis. We believe the standard will also continue to protect a right to use *some* elements of a trademark for humorous purposes.

In the facts presented here, we do not believe VIP has met the burden of disproving a sufficiently compelling likelihood of confusion. VIP contends a difference between using parody to advertise a product and using parody to make a product. For the purposes of the arguments asserted, the Court sees no substantive difference between the two. Whether parody is used to advertise or create a product has no bearing on whether the parody takes from the intellectual property of another.

VIP also argues that because it has not used a trademark symbol, such as ® or ™, they have made no claim of a protectable trademark. This argument is essentially like that where a defendant attempts to disprove likelihood of confusion by a disclaimer, and we reject it. Affirming VIP's argument would make it far too easy to mimic a mark and plaster a disclaimer on the product to skirt around a possible trademark violation.

Finally, VIP argues that because JDP sells liquor and VIP sells pet products, the likelihood of confusion is too low to establish brand dilution. We disagree. JDP has a well-known

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trademark, and VIP's Bad Spaniels toy shares such a strong similarity to JDP's trade dress—these elements should weigh heavily in a factor test. As mentioned above, much of a brand's strength is generated in the mental associations conducted by consumers. The products sold here have a significant tendency to create negative associations with JDP's brand, especially considering the fact that JDP manufactures and sells branded merchandise like apparel that increases the brand's visibility. At any point, JDP could rightly decide to make branded dog toys for the same brand visibility purpose, which would only strengthen the negative associations that VIP's product creates with their Bad Spaniels product.

Consequently, we disagree with the Court of Appeals' reasoning that VIP's product was insulated from infringement liability because of First Amendment protections, and we reverse the judgment of the Court of Appeals on this issue.

## III

We also address whether use of another's mark as one's own on a commercial product is "noncommercial" under 15 U.S.C. § 1125(c)(3)(C). We hold that such use is not noncommercial.

The Trademark Dilution Revision Act ("TDRA"), 15 U.S.C. § 1125(c)(3), provides fair-use exceptions to a dilution cause of action challenging a defendant's use of another's mark. Under the statute, a party may bring a cause of action for dilution by blurring or dilution by tarnishment, except when there is, *inter alia*, "[a]ny noncommercial use of a mark." *Id.*

At dispute is whether VIP's use of JDP's mark is "noncommercial" in the context of the TDRA, § 1125(c)(3)(C). The

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TDRA does not explicitly define “noncommercial use.” However, a textual and contextual analysis of the statute would lead one to conclude that “noncommercial” as purported in the TDRA means any good or service sold in commerce. “Noncommercial” can be translated to “not commercial.” *Webster's Third New International Dictionary of the English Language* 1536 (2002). Dictionaries define “commercial” as “concerned with or engaged in” “the activity of buying and selling,” often in the context of “making or intending to make a profit,” *The New Oxford American Dictionary* 341 (2d ed. 2005).

The TDRA defines “use in commerce” as use of a mark “in the ordinary course of trade,” including when a mark is placed on goods “sold” or merely “transported in commerce.” § 1127. Congress invoked its commerce clause authority when enacting the statute, so it is reasonable to conclude that it intended to exclude only use of a mark that is unrelated to the sale of goods or services because such regulation might expose the statute to constitutional challenges. And precedent affirms this interpretation of the meaning of “commercial.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 584 (1994) (holding that use of parody when selling songs is commercial “since these activities are generally conducted for profit”). Thus, “noncommercial use” can be taken to mean any use of a mark that is not in the ordinary course of trade, i.e., when selling or transporting a good or service in commerce, regardless of whether the good or service is sold for a profit.

However, the Court of Appeals interpreted “noncommercial use” differently here. The court held that the noncommercial-use exception in the TDRA is any use of a mark involving humor or expression, which would include VIP's use of JDP's marks and

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trade dress to sell the Bad Spaniels toy. Because this interpretation disagrees with judicial canons of interpretation, it was improper. As discussed above, the plain and statutory meanings of the term “commercial” are very clear and consistent. And *expressio unius est exclusio alterius* suggests that when a statute includes a list of specific items, that list is presumed to be exclusive; the statute applies only to the listed items and not to others, unless otherwise stated. The TDRA lists two other exclusions without any suggestion that the list is non-exhaustive. As a matter of constitutional avoidance, we presume that Congress considered speech protections when drafting the TDRA, and § 1125(c)(3) is evidence of this. Thus, any imposition of another exclusion by the Court of Appeals was improper.

Applying our rules, VIP’s Bad Spaniels toy falls within the purview of the Lanham Act and is subject to infringement and dilution liability.

\* \* \*

Because the facts here are subject to the Lanham Act and VIP has failed to proffer sufficient facts to counter a substantially compelling likelihood of confusion between its toy product and JDP’s trade dress, the judgment of the Court of Appeals was improper. We reverse that judgment and remand the case to the District Court for further proceedings in accordance with this opinion.

*It is so ordered.*